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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/797,485

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Vahid Saadat

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LEVINE BAGADE HAN LLP
2400 GENG ROAD, SUITE 120
PALO ALTO, CA 94303

EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

05/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/797,485	Applicant(s) SAADAT ET AL.	
	Examiner MATTHEW J. KASZTEJNA	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 67-71, 73, 74, 76-80, 82-84, 92 and 94-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 67-71, 73, 74, 76-80, 82-84, 92 and 94-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 15, 2009 has been entered.

Notice of Amendment

In response to the amendment filed on April 15, 2009, amended claims 67 and 92; canceled claim 75; and new claims 95-96 are acknowledged. The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 95 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 95 recites the limitation "said member" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 67-71, 73-74, 76-80, 82-83, 92 and 94-96 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,251,611 to Zehel et al.

In regards to claims 67 and 92, Zehel et al. disclose an endoluminal apparatus 1 comprising: an elongated main body having a proximal end, a distal end 12, a longitudinal axis and at least one lumen 29 extending through the main body the main body having at least a first section 10 near the proximal end and a second section 11 near the distal end (see Fig. 8), and with the first section comprising a plurality of nested links 19 with substantially all adjacent links having mating surfaces that are in contact with but that are not connected to each other (see Fig. 3) and having a plurality of first pullwire lumens 21, a plurality of first pullwires 20 routed through substantially each of the first pullwire lumens, with each of the first pullwires being fixed to the elongated main body at a location at or near a distal end of the first section and at substantially a common point along the longitudinal axis of the main body, the first pullwires being substantially symmetrically spaced around the periphery of the nested links of the first section (see Figs. 2 and 4 and Col. 6, Line 60 – Col. 7, Line 15), a tensioning mechanism 16 operatively coupled to each of the first pullwires and adapted to impart tension force that is substantially evenly distributed to each of the first pullwires (see

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Col. 7, Lines 40-50), wherein the first section may be selectively switched between a substantially flexible condition and a substantially rigid condition (see Col. 7, Lines 1-14) wherein the second section is steerable relative to the first section (see Col. 5, Lines 1-27); and a scope being movable through the lumen relative to the elongated main body (see Col. 6, Lines 14-16 and Col. 8, Lines 40-42).

In regards to claim 68, Zehel et al. disclose an endoluminal apparatus, wherein the main body includes a torque transmitting feature which provides torque transmission between the proximal and distal ends while the main body is unlocked, to cause the main body to rotate substantially about its central axis (see Col. 5, Line 65 – Col. 6, Liner 10).

In regards to claim 69, Zehel et al. disclose an endoluminal apparatus, comprises an atraumatic tip 40 having at least one opening corresponding to the at least one lumen (see Figs. 7-8 and Col. 9, Lines 20-40).

In regards to claim 70, Zehel et al. disclose an endoluminal apparatus, wherein the second section 11 may be switched between a flexible state and a substantially rigid state independently of the first section (see Col. 5, Lines 1-27).

In regards to claim 71, Zehel et al. disclose an endoluminal apparatus, with substantially each link in the first section configured to allow partial rotation relative to adjacent links and with the links arranged so that the first section can bend in at least two dimensions (see Figs. 5-6 and Col. 7, Line 63 – Col. 8, Line 10).

In regards to claims 73-74, Zehel et al. disclose an endoluminal apparatus, wherein the second section is steerable in up to three dimensions relative to the first section (see Col. 5, Lines 1-15).

In regards to claim 76, Zehel et al. disclose an endoluminal apparatus, further comprising at least two liners 10, 11 extending along a length of the elongated main body (see Fig. 1).

In regards to claim 77, Zehel et al. disclose an endoluminal apparatus, wherein at least one liner can transmit torque (see Col. 4, Lines 49-67).

In regards to claims 78-79, Zehel et al. disclose an endoluminal apparatus, further comprising a liner creating a lumen in the main body (see Figs. 8-9 and Col. 8, Lines 40-42). It is well known within the art to provide a hydrophilic coating on coaxial liners.

In regards to claim 80, Zehel et al. disclose an endoluminal apparatus, wherein the scope comprises an endoscope extendable through the main body, with the scope having a steerable tip (see Col. 6, Lines 14-16 and Col. 8, Lines 40-42).

In regards to claim 82, Zehel et al. disclose an endoluminal apparatus, further comprising an insufflation lumen within the main body (see Col. 5, Lines 55-57).

In regards to claim 83, Zehel et al. disclose an endoluminal apparatus, wherein a first end of the endoscope is *positionable* in an off-axis position relative to the elongated main body such that a region of interest spaced apart from the elongated main body may be viewed at an angle via the endoscope (see Col. 6, Lines 11-19).

In regards to claim 94, Zehel et al. disclose an endoluminal apparatus, with the second section comprising a plurality of links (see Col. 8, Lines 60-63).

In regards to claim 95, Zehel et al. disclose an endoluminal apparatus, wherein the member positioned at a distal end of the first section is one of the plurality of nested link (see Fig. 2 and Col. 6, Lines 60-67).

In regards to claim 96, Zehel et al. disclose an endoluminal apparatus, wherein the tensioning mechanism comprises a pulley and wherein at least one of the first pullwires is routed through the pulley (see Col. 7, Lines 40-50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 84 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,251,611 to Zehel et al. in view of U.S. Patent No. 3,897,775 to Furihata.

In regards to claim 84, Zehel et al. disclose an endoluminal apparatus for a variety of endoscopic procedures (see rejection above) but are silent with respect to a Y-port located along the first section, wherein the Y-port is in communication with at least one lumen extending through the elongated main body. Furihata teaches of an analogous apparatus having a Y-Port 37 located proximally along the endoscope apparatus (see Fig. 3 and Col. 4, Lines 35-55). It would have been obvious to one

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skilled in the art at the time the invention was made to include a Y-port in the apparatus of Zehel et al. to enable a user to introduce additional surgical instruments at a desired site within the body as taught by Furihata.

Response to Arguments

Applicant's arguments with respect to claims 67-71, 73-74, 76-80, 82-84, 92 and 94-96 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. KASZTEJNA whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew J Kasztejna/
Examiner, Art Unit 3739

5/19/09